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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,108	08/28/2000	Lieping Chen	07039-220001	7772

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EXAMINER

OUSPENSKI, ILIA I

ART UNIT	PAPER NUMBER
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1644

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/649,108	Applicant(s) CHEN, LIEPING	
	Examiner ILIA OUSPENSKI	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 8 and 10-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 9 and 49-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/21/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 51 are pending.

Claims 1 – 5, 8, and 10 – 48 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected Inventions/Species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 02/28/2002.

Claims 6 – 7, 9, and 49 – 51 are under consideration in the instant application.

2. Applicant's IDS, filed on 05/21/2004, is acknowledged, and has been considered.

It is noted that only one of two pages of the document appears to be present in the file of this application. Applicant is invited to resubmit page 2 of the IDS to complete the record.

3. Claims 6 – 7, 9, and 49 – 51 have been previously rejected under 35 USC 102(e) as anticipated by Freeman et al. (US Pat. Pub. No. 2002/0102651; of record; based on application USSN 10/002,775), which claims the same invention (see Office Action mailed on 01/15/2003). Applicant has requested, in a response filed on 01/20/2004, that the rejection be held in abeyance until the Freeman application has issued as a US Patent.

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Application USSN 10/002,775 has issued as US Patent No. 7,038,013.
Rejection of the instant claims as anticipated by Freeman et al. (US Patent No. 7,038,013) is set forth herein.

4. It is noted that Applicant has filed a Declaration under 37 CFR 1.131, by Dr. Lieping Chen, on 06/16/2003. This Declaration has not been deemed sufficient to overcome the rejection of the instant claims under 35 USC 102(e) as anticipated by Freeman et al. (US Pat. Pub. No. 2002/0102651), as addressed in the Office Action mailed on 07/17/2003. In particular, it was noted that an affidavit or declaration under 37 CFR 1.131 is inappropriate when the reference is claiming the same patentable invention (see section 8 of Office Action mailed on 07/17/2003). See MPEP 2305. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings.

5. The following is a quotation of the appropriate paragraphs of **35 U.S.C. 102** that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 6 – 7, 9, and 49 – 51 are rejected under **35 U.S.C. 102(e)** as being anticipated by Freeman et al. (US Patent No. 7,038,013; see entire document).

Freeman et al. teach and claim the human B7-4 polypeptide of SEQ ID NO:4 encoded by SEQ ID NO:1 (see entire document, including sequence listing and Figures, and in particular, claim 1). SEQ ID NO:4 is taught e.g. in Example 4 (column 65) to costimulate T cells. The complement of the nucleic acid of SEQ ID NO:1 of Freeman et al. would hybridize to SEQ ID NO:1 of Freeman et al. after a wash at 65 degrees C in a buffer containing 0.2x SSC and 0.1% SDS; therefore SEQ ID NO:1 itself is a nucleic acid that hybridizes as recited in instant claim 6 and encodes a polypeptide which co-stimulates a T cell (see claim 5).

SEQ ID NO:4 of Freeman et al. is a polypeptide of 290 amino acids that is identical to instant SEQ ID NO:1 over its full length (see the attached alignment). Therefore, the B7-4 polypeptide of Freeman et al. is a polypeptide comprising: amino acid residue 23 to amino acid residue 290 of instant SEQ ID NO:1; SEQ ID NO:1 itself; and SEQ ID NO:10 (the extracellular domain of SEQ ID NO:1).

Freeman et al. also teach and claim polypeptides which differ from the B7-4 polypeptide set forth in SEQ ID NO:4 of Freeman et al. by one or more conservative amino acid substitutions (see e.g., columns 15 – 16), or are at least 95% identical to SEQ ID NO:4 (claim 11).

The reference teachings thus anticipate the instant claimed invention.

7. It is noted that Applicant's Declaration under 37 CFR 1.131, by Dr. Lieping Chen, filed on 06/16/2003, is ineffective to overcome the above rejection, for the same reasons as set forth in section 4 above. Applicant is invited to provide a priority showing under **37 CFR 41.202(d)**. See MPEP chapter 2300; in particular, §§ 2304.02 and 2305.

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8. Conclusion: no claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ILIA OUSPENSKI, Ph.D.

Patent Examiner

Art Unit 1644

January 18, 2007

Phillip Cambel
PHILLIP CAMBEL, Ph.D. JS
PRIMARY EXAMINER
R 1600
1/18/07